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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,596	08/22/2003	Mojtaba Shariat	Shariat 8-1 (LCNT/125128)	9799

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EXAMINER	
NGUYEN, BRIAN D	

ART UNIT	PAPER NUMBER
2616	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/646,596	SHARIAT ET AL.	
	Examiner	Art Unit	
	BRIAN D. NGUYEN	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) *20-24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19 and 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 1-19 and 25, in the reply filed on 7/11/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Objections

2. Claims 1, 4, 10, and 13 are objected to because of the following informalities:

Claims 1, 4, 10, and 13, the terms: "adapted for" and "adapted to" are not positively recited limitations. It is suggested to delete these terms from the claims. Note that limitations followed "adapted to/for" are not considered claimed limitations.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-14, 16-19, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Ylitalo (2004/0204111) and Kekki (2005/0286528).

Regarding claim 1, both Ylitalo and Kekki discloses a communication system for transporting Internet protocol-formatted communications over a Universal Mobile Telecommunications System (UMTS) wireless communications system, the communication system including a base station and a radio network controller (see, for example, 152 and 146 of Ylitalo and figures 1 and 3 of Kekki), the communication system further comprising: an inter-working gateway (see 157 of Ylitalo and IWF in figure 4 of Kekki) adapted for interconnection to the radio network controller and the base station, the inter-working gateway being adapted to communicate via Internet transport protocols and UMTS-based transport protocols, the inter-working gateway being further adapted to reformat communications with movable UMTS-based radio-controlled network layer protocols for transport to the radio network controller and to reformat communications with movable Internet radio-controlled network layer protocols for transport to the base station (see figure 1 of Ylitalo where the gateway 157 reformat communications between BTS 152 and RNC 146 and IWF of Kekki where the IWF reformat between AAL2 UTRAN node and IP UNTRAN node).

Regarding claims 2 and 11, both Ylitalo and Kekki disclose the UMTS communications system exists at an installed site (see figure 1 of Ylitalo and figure 4 of Kekki).

Regarding claims 3 and 12, both Ylitalo and Kekki discloses the inter-working gateway is supplied as pre-installed with the transport protocols (see figure 1 of Ylitalo and figure 4 of Kekki).

Regarding claims 4 and 13, both Ylitalo and Kekki disclose the inter-working gateway is adapted to receive and download the radio-controlled network layer protocols and the transport protocols from the base station (see figure 1 of Ylitalo and figure 4 of Kekki).

Regarding claims 5 and 14, Ylitalo discloses the base station and the inter-working gateway are interconnected in a local area network (see figure 1 where BTSs 152 and 154 are connected to gateway 157 to form a LAN).

Regarding claims 7 and 16, both Ylitalo and Kekki disclose an interconnection of the inter-working gateway with the base station carries the communications reformatted with the movable UMTS-based radio-controlled network layer protocols in a first direction, and the communications reformatted with the movable Internet radio-controlled network layer protocols in a second direction (see gateway 157 of Ylitalo and IWF in figure 4 of Kekki. Note that gateway and interworking-functions perform protocol conversion).

Regarding claims 8 and 17, both Ylitalo and Kekki discloses an interconnection of the inter-working gateway with the radio network controller carries the communications reformatted with the movable UMTS-based radio-controlled network layer protocols in a first direction, and the communications reformatted with the movable Internet radio-controlled network layer protocols in a second direction (see gateway 157 of Ylitalo and IWF in figure 4 of Kekki. Note that gateway and interworking-functions perform protocol conversion).

Regarding claims 9 and 18, both Ylitalo and Kekki discloses an interconnection of the inter-working gateway with the base station carries the communications reformatted with the movable UMTS-based radio-controlled network layer protocols in a first direction, and the communications reformatted with the movable Internet radio-controlled network layer protocols in a second direction, and an interconnection of the inter-working gateway with the radio network controller carries the communications reformatted with the movable UMTS-based radio-controlled network layer protocols in a first direction, and the communications formatted

with the movable Internet radio-controlled network layer protocols in a second direction (see gateway 157 of Ylitalo and IWF in figure 4 of Kekki. Note that gateway and interworking-functions perform protocol conversion).

Regarding claim 10, both Ylitalo and Kekki discloses a Node-B base station adapted for transmitting and receiving cellular telephone communications, the Node-B base station being interconnected with the radio network controller for exchanging wireless cellular telephone communications (see Node B 152 of Ylitalo and Node B in figure 3 of Kekki).

Regarding claim 19, both Ylitalo and Kekki discloses an inter-working gateway (see 157 of Ylitalo and IWF in figure 4 of Kekki) for wirelessly transporting Internet protocol-formatted communications in a Universal Mobile Telecommunications System (UMTS) communications system, the inter-working gateway comprising: means for communicating via Internet transport protocols and UMTS-based transport protocols; means for reformatting communications using movable UMTS-based transport protocols for transport to a radio network controller; and means for reformatting communications using movable Internet radio-controlled network layer protocols from the radio network controller to the inter-working gateway (see BTS 152 with internet protocol (IP) of Ylitalo and IP UTRAN and ALL2 UTRAN of Kekki in figure 4).

Regarding claim 25, claim 25 is a method claim that has substantially all the limitations of the respective apparatus claim 19. Therefore, it is subject to the same rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ylitalo or Kekki in view of Verma et al (2005/0210154).

Regarding claims 6 and 15, Ylitalo and Kekki does not specifically disclose the communications system comprising elements such as SDRAM memory, a digital signal processor and associated flash memory and an application specific integrated circuit to manage baseband processing, and a microprocessor. However, a UMTS that includes these elements are well known in the art Verma discloses a UMTS system that includes those elements (see, for example, paragraph 0016). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include memory and processors as taught by Verma in the system of Ylitalo or Kekki in order to store and process information when needed.

Response to Arguments

7. Applicant's arguments filed 1/14/08 have been fully considered but they are not persuasive.

With respect to "adapted to" and "adapted for", Claim 1, line 8, for example, "adapted to reformat…" is a statement of intended use, field of use, or optional.

With respect to Ylitalo reference, the applicant argues that *Ylitalo discloses a gateway interconnecting an IP BTS of an IP RAN network and an RNC of a UTRAN network. By contrast, Applicants' claim 1 claims an inter-working function adapted for interconnection to a base station of a UMTS network and an RNC of a UMTS network. The IP BTS of the IP RAN, as*

disclosed in Ylitalo, is not a base station of a UMTS, as claimed in Applicants' claim 1. Thus, Ylitalo fails to teach or suggest at least the limitation of "an inter-working gateway adapted for interconnection to the radio network controller and the base station," as claimed in Applicants' claim 1. This argument is irrelevant because the claims do not claim "a base station of a UMTS network" and the specification doesn't seem to disclose the base station belongs to the UMTS network. Note that elements 34 and 38 in figure 2 of this application is the same as elements 142 and 146 of Ylitalo and elements 40, 48, and 44 in figure 4 of this application is the same as elements 152, 157, and 146 of Ylitalo.

With respect to Kekki, the applicant argues that *Kekki fails to teach or suggest at least the limitation of "the inter-working gateway being further adapted to reformat communications with movable UMTS-based radio-controlled network layer protocols for transport to the radio network controller and to reformat communications with movable Internet radio-controlled network layer protocols for transport to the base station" as claimed in Applicants' claim 1.* The examiner respectfully disagrees because figure 1 clearly shows an IWF for reformatting communication in UMTS network (UTRAN) with one side represents the ATM/AAL2 domain and the other represents the IP domain. Paragraph 0030 further teaches that the IWF can be implemented as a standalone node or as part of any other network node for example IP BTS, RNC, some gateway or server.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN D. NGUYEN whose telephone number is (571)272-3084. The examiner can normally be reached on 7:30-6:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on (571) 272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

3/17/08

/Brian D Nguyen/
Primary Examiner, Art Unit 2616